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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,177	02/26/2002	Christopher R. Tudan	080421-000100US	1250

20350 7590 08/28/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

BUNNER, BRIDGET E

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 10/086,177	<b>Applicant(s)</b> TUDAN ET AL.	
	<b>Examiner</b> Bridget E. Bunner	<b>Art Unit</b> 1647	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 15 March 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☒ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☒ Newly proposed or amended claim(s) 35 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 23 and 27-32.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☒ Other: Note the attached Interview Summary form (PTOL-413).

Continuation of 3. NOTE: If the response filed 27 July 2006, had been entered, the objection to claim 28 would have been withdrawn. If the amendment filed 27 July 2006 had been entered, the rejections of claims 23 and 27-32 under 35 U.S.C. § 112, first paragraph (scope of enablement, written description, and new matter) would have been withdrawn in view of the cancelled claims.

If the amendment of 27 July 2006 had been entered, claim 35 would have been allowable and claim 34 would have been objected to as being dependent upon a rejected base claim.

New claim 33 would raise new issues under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner could not find support for the agonist "formula" recited in lines 1-2. Additionally, support for the term " $(CH_2)_{1-20}$ " in the last line of the claim could not be located in the specification. Although Applicant states that support can be found for this limitation at pg 44 of the specification, this section of the specification is a general teaching of the linking moiety and an integer number. However, the Examiner found that the specification teaches the linker may be  $(CH_2)_{0-20}$  (see for example pg 17, line 5; pg 62, line 4; sequence listing).

Additionally, claim 33 would raise new issues under 35 U.S.C. § 112, first paragraph (scope of enablement). As discussed for claims 23 and 27-32 in the previous Office Action and the Office Action of 18 January 2005, a large quantity of experimentation would be required of the skilled artisan to generate an agonist peptide with the large number of linkers recited in the claim, other than a linker with 4 glycine residues. At pg 5-6 of the previous Office Action, the Examiner cited Luo et al. 1999 to teach that utilization of the 4 glycine residue linker allows N- and C- terminal SDF fragments to adopt a spatial orientation similar to the native structure. Thus, one skilled in the art would not be able to predict the proper structural orientation and function of SDF analogs with different types and numbers of linkers. Applicant has not provided any evidence indicating that the spacer region is not critical to function (see pg 45 of 24 July 2006 Response).

Claim 33 would also raise new issues under 35 U.S.C. § 112, second paragraph for the recitation of "(SEQ ID NOS: 208-210)". It is unclear what proteins the three SEQ ID NOS: are referring to since there is only one agonist formula recited in the claim.

*Bridget E. Bunner*

**BRIDGET BUNNER  
PATENT EXAMINER**